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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,496	12/07/2000	Anthony J. Durkin	CDL-031	1265

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EXAMINER
DAHBOUR, FADI H

ART UNIT	PAPER NUMBER
3742	

DATE MAILED: 10/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/731,496	DURKIN ET AL.	
	Examiner	Art Unit	
	Fadi H. Dahbour	3742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 05 April 2001 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 34 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 14, 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, at line 1, the number "17" should be changed to –20--. Correction is required.

Claim 14, at line 1, recites the limitation "the thermal change". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1-15, 17-30, 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Neev ('739).

Neev discloses a method of treating acne in a preselected region of mammalian skin having at least one acne lesion disposed therein (Figs.1-10), comprising cooling an exposed surface of the preselected region (see "cooled" in line 16 of col.3), and exposing the preselected region to a beam of radiation comprising a wavelength in the range from about 0.6 microns to about 1.8 microns to ameliorate the lesion (see "laser... wavelength...from 300 nanometers to 2 microns" in lines 60 & 63 & 65 of col.8), wherein the wavelength is in the range from about 1.2 to about 1.7 microns (see "from 300 nanometers to 2 microns" in line 65 of col.8), wherein the wavelength is in the range from about 1.3 to about 1.6 microns (see "from 300 nanometers to 2 microns" in line 65 of col.8), wherein the wavelength is about 1.5 microns (see "from 300 nanometers to 2 microns" in line 65 of col.8), wherein the beam of radiation has a power density in the range from about 1 to about 10,000 watts per square centimeter (see lines 1-8 of col.9), wherein the power density is in the range from about 5 to about 5,000 watts per square centimeter (see lines 1-8 of col.9), wherein the beam of radiation has a fluence in the range from about 5 to about 500 joules per square centimeter (see lines 1-8 of col.9), wherein the fluence is in the range from about 10 to about 150 joules per square centimeter (see lines 1-8 of col.9), wherein step-a occurs prior to step-b (see "cooled, preceding and/or following" in lines 16-17 of col.3), wherein step-a occurs contemporaneously with step-b (see "cooling...during" in lines 25-26 of col.10), further comprising the additional step of prior to step-b providing a radiation absorbing material

to the preselected region (see "absorption substance...prior to" in line 67 of col.3, and line 1 of col.4), wherein applying energy in step-b reduces the size of a lesion disposed within the preselected region (see "to decrease the size of a skin lesion" in line 66 of col.4), wherein applying energy in step-b reduces the density of lesions disposed within the preselected region (see "removal of skin lesions" in lines 23-24 of col.18), wherein applying energy in step-b reduces lesion-associated skin-inflammation in the preselected region (see "to decrease the size of a skin lesion" in line 66 of col.4, also see "removal of skin lesions" in lines 23-24 of col.18), wherein in step-b the energy is provided by a laser light, incoherent light, microwaves, ultrasound or RF current (see "laser" in line 60 of col.8), wherein in step-b the energy is provided by laser light (see "laser" in line 60 of col.8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 16, 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neev ('739) in view of the admitted prior art.

Neev further comprises the disorder being acne (see "acne" in lines 63-64 of col.3). Neev lacks the disorder being acne vulgaris. The admitted prior art discloses acne vulgaris (see "acne vulgaris" in line 7 of page 2 of Applicant's specification).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the feature taught by the admitted prior art, in the method of Neev, because the admitted prior art teaches that it is known that acne vulgaris is form of acne (see "acne vulgaris is...form of acne" in lines 7-8 of page 2 of Applicant's specification, also see "known" in line 8 of page 2 of Applicant's specification).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Neev ('590), Neuberger et al, McDaniel, Chernoff, Abergel et al, Cone, Salansky et al, Loeb et al and Smith are cited to show methods of treatment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fadi H. Dahbour whose telephone number is 703-306-5479.

T. Walberg

Teresa Walberg
Supervisory Patent Examiner
Group 3700

October 4, 2002